

**S/N 10/648,125**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant: Steve Grove et al.

Examiner: Cam Y T Truong

Serial No.: 10/648,125

Group Art Unit: 2169

Filed: August 25, 2003

Docket No.: 2043.102US1

Customer No.: 49845

Confirmation No.: 3210

Title: METHOD AND SYSTEM TO GENERATE A LISTING IN A NETWORK-BASED  
COMMERCE SYSTEM

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**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

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This Reply is presented in response to the Examiner's Answer ("the Answer"), dated October 14, 2010, which was sent in answer to Appellants' Appeal Brief ("the Appeal Brief"), filed on July 16, 2010. The Appeal Brief was filed in response to the rejection of claims 1-7, 9-19, 21-29, 31-36 and 39-45 of the above identified application.

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## **REPLY**

This Reply is presented in response to the Answer. Appellants have reviewed the Answer and believe that the statements in the Appeal Brief remain accurate and compelling.

Appellants will briefly address the Examiner's responses to the arguments in the Appeal Brief below.

## **SUMMARY**

### **A. THREE NEW GROUNDS OF REJECTION**

### **B. THE ANSWER DOES NOT ADDRESS APPELLANTS' "ARTICULATED REASONING" ARGUMENT**

### **C. THE ANSWER IMPERMISSIVELY SUBSTITUTES "LIST" FOR "LISTING"**

### A. THREE NEW GROUNDS OF REJECTION

The Examiner's Reply raises three new grounds of rejection in the following Responses to Arguments, as explained more fully below:

Answer, Response a, Page 36, line 19 to Page 37, line 17;  
Answer, Response b, Page 38, line 1 to Page 39, line 6; and  
Answer, Response c, Page 39, lines 11-21.

As for these new grounds of rejection, the MPEP § 1208.01 states:

#### 1208.01 Prohibition Against Entry of New Ground of Rejection in Answer

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an Answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

Appellants have not had an opportunity to address these new grounds of rejection in prosecution. If the Examiner is of the belief that the new grounds of rejection were necessary, the Examiner should have reopened prosecution pursuant to 37 CFR 1.193(a)(2). Accordingly, Appellants request withdrawal of the new grounds of rejection by the Examiner, or, in the alternative, reversal of the rejection by the Board of Patent Appeals and Interferences.

### An Explanation of the Three New Grounds of Rejection

#### *A.1 New Ground of Rejection in Response a, Page 36, line 19 to Page 37, line 17*

**Limitation:** "receiving a category selection from a seller"

Appellants in the Appeal Brief<sup>1</sup> argued that Boyden in view of Decker does not disclose the claim limitation "receiving a category selection from a seller." The Examiner then, at page

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<sup>1</sup>Appeal Brief, page 13, line 28 to page 14, line 12.

36, line 19, to page 37, line 17 of the Answer, disagreed and stated that Boyden teaches the above-quoted claim limitation.<sup>2</sup>

But the Final Office Action stated,<sup>3</sup> and the Answer earlier stated,<sup>4</sup> that “Boyden **does not** explicitly teach the claimed limitation ‘receiving a category selection from a seller’.”

By now<sup>5</sup> asserting that Boyden **does** disclose the above-quoted limitation, the Answer introduces a new ground of rejection.

Further, having argued at page 8, lines 17-18 of the Answer that the limitation is **not explicitly disclosed in Boyden**, the Examiner now goes on for over two pages in the Answer quoting from Boyden’s specification in an attempt to show that the limitation is **disclosed** in Boyden. The Examiner here is not asserting that this limitation is *inherently* disclosed in Boyden. Rather, the Examiner quotes directly from Boyden which seems by definition to be an attempt to illustrate that the limitation is **explicitly** disclosed in Boyden. So in addition to this being new grounds of rejection, it is also inconsistent with the position taken at page 8, lines 17-18. That is, the Examiner previously said the limitation is **not explicitly** disclosed in Boyden and now appears to be saying the limitation is **explicitly** disclosed in Boyden. This inconsistency should be prohibited by *judicial estoppel*.

As a separate issue, Appellants in the Appeal Brief<sup>6</sup> argued that Dicker does not disclose “receiving a category selection from a seller” as asserted in the Final Office Action.<sup>7</sup> So in addition to inserting a new ground of rejection, the Answer does not address Appellants’ argument that Dicker does not disclose the limitation. It appears the Answer does not address Appellants’ argument that the above-quoted limitation is not disclosed in Dicker because, in fact, the limitation is **not** disclosed in Dicker.

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<sup>2</sup> This is inconsistent with the Answer’s contradictory statement discussed with respect to Footnote 4

<sup>3</sup> Final Office Action, page 11, lines 20-21

<sup>4</sup> Answer, page 8, lines 17-18

<sup>5</sup> Answer, page 36, line 19 to page 37, line 17

<sup>6</sup> See Footnote 1

<sup>7</sup> Final Office Action, page 12, lines 6-8

*A.2 New Ground of Rejection in Response b, Page 38, line 1 to Page 39, line 6;*

**Limitation:** “verifying the category supports automated generation for proposed listings”

Appellants in the Appeal Brief<sup>8</sup> argued that Boyden in view of Decker does not disclose the claim limitation “verifying the category supports automated generation for proposed listings.” The Examiner then, at page 38, line 1, to page 39, line 6 of the Answer, disagrees and states that Boyden teaches the above-quoted claim limitation.<sup>9</sup>

But the Final Office Action stated,<sup>10</sup> and the Answer earlier stated<sup>11</sup> that “Boyden does not explicitly teach ‘verifying the category supports automated generation for proposed listings’.” (Emphasis added)

By now<sup>12</sup> asserting that Boyden does disclose the above-quoted limitation, the Answer introduces a new ground of rejection.

Further, having argued at page 8, lines 18-19 of the Answer that the limitation is not explicitly disclosed in Boyden, the Examiner now goes on for almost a page and a half in the Answer quoting from Boyden to show that the limitation is disclosed in Boyden. The Examiner here is not asserting that this limitation is *inherently* disclosed in Boyden. Rather, the Examiner quotes directly from Boyden which seems by definition to be an attempt to illustrate that the limitation is *explicitly* disclosed in Boyden. So in addition to this being new grounds of rejection, it is also inconsistent with the position taken at page 8, lines 18-19. That is, the Examiner previously said the limitation is **not explicitly** disclosed in Boyden and now appears to be saying the limitation is **explicitly** taught in Boyden. This inconsistency should be prohibited by *judicial estoppel*.

As a separate issue, Appellants in the Appeal Brief<sup>13</sup> argued that Dicker does not disclose “verifying the category supports automated generation for proposed listings” as asserted in the

<sup>8</sup> Appeal Brief, Page 14, line 13-page 15, line 4

<sup>9</sup> As with Response a, this is inconsistent with the Answer's contradictory statement; see footnote 11

<sup>10</sup> Final Office Action, page 11, line 21 to page 12, line 1

<sup>11</sup> Answer, page 8, lines 18-19

<sup>12</sup> Answer, page 38, line 1, to page 39, line 6

<sup>13</sup> See footnote 8

Final Office Action.<sup>14</sup> So in addition to inserting a new ground of rejection, the Answer does not address Appellants' argument that Dicker does not disclose the limitation. It appears the Answer does not address Appellants' argument that the above-quoted limitation is not disclosed in Dicker because, in fact, the limitation is not disclosed in Dicker.

*A.3 New Ground of Rejection in Response c, Page 39, lines 11-21*

**Limitation:** "receiving an indication from the seller selecting a selected listing from the plurality of similar listings"

The Examiner, at page 39, lines 11-21 appears to state that Boyden teaches the claim limitation "receiving an indication from the seller selecting a selected listing from the plurality of similar listings."

But the Final Office Action stated,<sup>15</sup> and the Answer earlier stated<sup>16</sup> that "Boyden does not explicitly teach the claimed limitation "receiving an indication from the seller selecting a selected listing from the plurality of similar listings."

By now<sup>17</sup> asserting that Boyden does disclose the above-quoted limitation, the Answer introduces a new ground of rejection.

Further, having argued at page 8, lines 19-20 of the Answer that the limitation is not explicitly disclosed in Boyden, the Examiner now cites Figs. 3C-3E of Boyden, and text from Boyden's specification, as showing that the limitation is disclosed in Boyden. The Examiner here is not asserting that this limitation is inherently disclosed in Boyden. Rather, the Examiner quotes directly from Boyden which seems by definition to be an attempt to illustrate that the limitation is explicitly disclosed in Boyden. So in addition to this being new grounds of rejection, it is also inconsistent with the position taken at page 8, lines 19-20. That is, the Examiner previously said the limitation is not explicitly disclosed in Boyden and now appears to

<sup>14</sup> Final Office Action, page 12, lines 9-10

<sup>15</sup> Final Office Action, page 12, lines 1-2

<sup>16</sup> Answer, page 8, lines 19-20

<sup>17</sup> Answer, page 39, lines 11-21

be saying the limitation **is explicitly** disclosed in Boyden. This inconsistency should be prohibited by *judicial estoppel*.

As pointed out at page 3 of this paper, Appellants have not had an opportunity to address these three new grounds of rejection in prosecution. If the Examiner is of the belief that the new grounds of rejection were necessary, the Examiner should have reopened prosecution pursuant to 37 CFR 1.193(a)(2). Accordingly, Appellants request withdrawal of the new grounds of rejection by the Examiner, or, in the alternative, reversal of the rejection by the Board of Patent Appeals and Interferences.

#### **B. THE ANSWER DOES NOT ADDRESS APPELLANTS' "ARTICULATED REASONING" ARGUMENT**

Appellants argued in the Appeal Brief<sup>18</sup> that the Final Office Action, in the rejection under discussion, does not meet the "articulated reasoning" test required by the MPEP because the reason given to combine Boyden and Dicker misstates the claim when explaining the reasoning used for combining Boyden and Dicker. If the reasoning uses a misstatement of the claim as the very purpose for combining the two references, it is not the required articulated reasoning.

However, the Answer<sup>19</sup> merely restates the law on obviousness without addressing Appellants' position that the rejection in the Final Office Action does not meet the articulated reasoning test. Worse, the Answer merely restates the above reasoning of the Final Office Action in reasserting the obviousness rejection, again misstating the purpose of the claim and giving the *wrong reason* for combining the two references. The answer's misstatement of the purpose of combining Boyden and Dicker is:<sup>20</sup>

...in order to allow a user select a particular similar item listing so that the service can retrieve another similar item lists based on the selected similar list and further to predict the interests of users

<sup>18</sup> Appeal Brief, page 16, line 17 to page 19, line 11

<sup>19</sup> Answer, page 42, lines 1-21

<sup>20</sup> Answer, page 42, lines 17-21

based on the user's indication so that the system provide a recommendation of similar items based on the interests of users...(Emphasis added)

Applicant's claim simply doesn't say this. Further, the purpose of the claim simply is not the purpose in the underscored statement in the quotation next above. Appellants' position, not addressed in either the Final Office Action or the Answer, is that if the rejection uses a misstatement of the purpose of the claim as the purpose for combining the two references, the rejection does not meet the required articulated reasoning.

### C. THE ANSWER IMPERMISSIVELY SUBSTITUTES "LIST" FOR "LISTING"

The claim element under discussion<sup>21</sup> addresses "listings." The Answer fails to address "listings" and instead substitutes the term "list" for the term "listing."

As The Appeal Brief points out<sup>22</sup> the meaning of "listing" is clearly pointed out in Appellants' specification as:

The meaning of "**listing**" can be understood from paragraph [0050] of the application:

**Listing creation** applications 60 allow sellers conveniently to author listings pertaining to goods or services that they wish to transact via the commerce system ....

As used in the specification, a listing is something authored by a seller. However, the Final Office Action<sup>23</sup>, and the Answer,<sup>24</sup> impermissibly substitutes "list" for "listing" and then attempts to segue from "list" to "listing" in a way that is inapposite:

The selected category is verified to support automated generation for recommendations lists as proposed listings (Fig. 5, paragraphs 0156, 0165-1067). Selecting similar items from a plurality of similar listings and displayed to a user (Figs. 11-12, paragraphs 0004, 0006) (Emphasis added)

<sup>21</sup> The claim element is Limitation (L7) "receiving an indication from the seller selecting a selected listing from the plurality of similar listings." (Emphasis added)

<sup>22</sup> Appeal Brief, page 7, lines 4-8

<sup>23</sup> Final Office Action, page 12, lines 9-12

<sup>24</sup> Answer, page 44, line 19 to page 45, line 2



First, notice that the Answer equates “recommendations lists” with “proposed listings.” This is simply wrong. As illustrated in the meaning of “listing” quoted above from the application, a list is not a listing. A list is a written series of items. A listing, on the other hand, is a description of attributes of an item. The Examiner even **states** this in making the argument justifying the rejection.<sup>25</sup>

Similarly, Dicker provides a method for searching **items** (not listings) in a database (paragraph 0063). (Emphasis and explanatory parenthetical added)

The Examiner’s own words confirm Appellant’s contention that a list is not a “listing.” Searching through items in a database is different from searching a listing of such items. But the claim requires a listing.

Second, as pointed out in The Appeal Brief,<sup>26</sup> Dicker does not discuss the claim limitation “verifying the category supports automated generation for proposed listings.” Appellants point out at page 5, lines 11-16 of this paper, above, that the Answer does not address Appellants’ argument that Dicker does not disclose this limitation. Then, without addressing the argument at all, the Answer makes the conclusory statement<sup>27</sup> that “The selected category is verified to support automated generation for recommendations lists as proposed listings (fig. 5, paragraphs 0156, 0165-0167) (Emphasis added)” with no reasoning, as if the limitation “verifying the category supports automated generation for proposed listings” has somehow been shown. It has **not**. Cited paragraph [0165] goes to weighting lists (again, lists not listings) and cited paragraphs [0165] to [0167] go to a process of sorting and scoring in order to place the most relevant items at the top of the list (again, a list, not listings as the claim requires).

Third, part of the limitation (L7) “selecting similar items from a plurality of similar listings and displayed to a user” is alleged in the Answer<sup>28</sup> to be disclosed at Figs. 11-12, paragraphs 0004, 0006 of Dicker. But a reading of paragraph [0006] of Dicker shows<sup>29</sup> that what is referred to is:

<sup>25</sup> Answer, page 44, lines 14-15

<sup>26</sup> Appeal Brief, page 14, lines 6-10

<sup>27</sup> Answer, page 44, line 19 to page 45, line 1

<sup>28</sup> Answer, page 45, lines 1-2

<sup>29</sup> Dicker, paragraph [0006], lines 9-11

“Some systems, such as those described instead require users to create lists of their favorite items. ... Through this explicit rating or list crating process, each user builds a personal profile of his or her preferences.”

Again, as illustrated by the very citation made in the Answer and quoted next above, Dicker creates “lists of their favorite items.” Dicker has to do with lists, not listings, which is required in Appellants’ claims.

### CONCLUSION

For the reasons argued above, independent claims 1 and 13 and their dependent claims were not properly rejected under § 103 as being obvious over Boyden in view of Dicker.

For the reasons argued above, independent claim 23 and its dependent claims were not properly rejected under § 103 as being obvious over Boyden in view of Dicker.


It is respectfully submitted that the art cited does not render the claims anticipated and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

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